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1 RECORD OF ORAL HEARING

2 UNITED STATES PATENT AND TRADEMARK OFFICE

3
4 BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7 *Ex parte* VERONIQUE DOUIN, BENEDICTE CAZIN,
8 and SANDRINE DECOSTER
9

10 Appeal 2008-0587
11 Application 09/765,675
12 Technology Center 1600
13

14 Before DONALD E. ADAMS, ERIC B. GRIMES, and LORA M. GREEN,
15 *Administrative Patent Judges.*

16 ON BEHALF OF THE APPELLANTS:

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22 The above-entitled matter came on for hearing on Thursday, June 12,
23 2008, commencing at 1:00 p.m., at the U.S. Patent and Trademark Office,
24 600 Dulany Street, Alexandria, Virginia, before Janice A. Salas, Notary
25 Registration No. 264765, Notary Public.

1 PROCEEDINGS

2 THE CLERK: Good afternoon. Calendar number 22, Mrs. Herzfeld.

3 JUDGE ADAMS: Good afternoon, Mrs. Herzfeld.

4 MS. HERZFELD: Hi. How are you?

5 JUDGE ADAMS: We're familiar with the issues and you'll have 20
6 minutes. If you could, when you're ready, introduce your colleague and
7 spell your name into the record for us, I'd appreciate it.

8 MS. HERZFELD: Yes. My name is Deborah Herzfeld. I'm
9 representing the appellant in this case.

10 JUDGE ADAMS: If you could spell your name into the record for us.

11 MS. HERZFELD: I'm sorry?

12 JUDGE ADAMS: Spell your name into the record for us.

13 MS. HERZFELD: H-E-R-Z-F as in Frank, E-L-D, and with me today
14 is Aaron Raphael, R-A-P-H-A-E-L.

15 So I'll begin just with a quick summary of the subject matter that's at
16 issue.

17 As I'm sure you know, the claim 1 relates to novel and unobvious oil
18 and water nanoemulsions comprising oil globules with an average size of
19 less than 150 nanometers comprising -- a composition comprising of at least
20 one oil, at least one amphiphilic liquid, and at least one cationic polymer
21 comprising at least one hydrophobic block and at least one hydrophilic block
22 where a nanoemulsion has a turbidity ranging from 60 NTU to 600 NTU.

23 It further relates to compositions for -- for keratin materials, topical
24 use, washing keratin materials, making up keratin materials, makeup
25 removing composition for keratin materials, nontherapeutic care processes,
26 process for thickening involving the emulsion described above.

1 There's also an independent claim directed towards a composition that
2 has at least one aminosilicone, but no turbidity limitation, and a composition
3 that has a nonionic polymer with a hydrophilic -- and a hydrophilic block
4 instead of the cationic polymer.

5 JUDGE ADAMS: And this is the second time this case has been --

6 MS. HERZFELD: Yes.

7 JUDGE ADAMS: -- with the Board. And in the first appeal there
8 was a combination of Restle and Ziegler that the Board found rendered
9 claim 1 obvious at the time.

10 MS. HERZFELD: Claim 1 not as it stands now.

11 JUDGE ADAMS: And the only difference between claim 1 as it
12 stands now and as it stood then was this turbidity range?

13 MS. HERZFELD: Correct. Because in the previous decision, the
14 Board held that the claims involving the turbidity limitation were not held
15 obvious by the combination of Restle and Ziegler.

16 In fact, the Board said that Restle and Ziegler do not discuss the
17 transparency or turbidity of the disclosed compositions, and therefore would
18 not have led those skilled in the art to expect that the composition resulting
19 from their combination would have the recited property.

20 JUDGE ADAMS: And the only difference between the rejections
21 before us -- what was that, back in 2004?

22 MS. HERZFELD: Mm-hmm.

23 JUDGE ADAMS: And the rejections before us now are this M and K
24 reference?

25 THE COURT REPORTER: I'm sorry. Which reference?

26

1 JUDGE ADAMS: The M reference and the K reference. It's
2 Margosiak and Knowlton.

3 MS. HERZFELD: And Knowlton. Yeah. Margosiak and Knowlton.

4 JUDGE ADAMS: And that's the only references and the only
5 difference in the set of rejections?

6 MS. HERZFELD: Essentially.

7 JUDGE ADAMS: And those two references go to this turbidity
8 range.

9 MS. HERZFELD: Correct.

10 JUDGE ADAMS: Okay. So we're limiting our discussion to whether
11 those references do or do not make up for what you consider to be the
12 deficiencies in what we've already found.

13 MS. HERZFELD: Correct.

14 JUDGE ADAMS: Okay.

15 MS. HERZFELD: Well -- and then also then discussing the other
16 dependent claims that were also -- that's all going to build on top of --

17 JUDGE ADAMS: Okay.

18 MS. HERZFELD: -- this for the most part.

19 So I can just jump right ahead there.

20 JUDGE ADAMS: Please.

21 MS. HERZFELD: The examiner sort of comes back now adding
22 Margosiak and Knowlton. His obviousness argument -- her obviousness
23 argument is essentially based on inherency.

24 The examiner in her answer writes, "It would have been obvious to
25 one of ordinary skill in the art that the Restle nanoemulsion, whose average
26 particle size of oil globules is smaller than 150 nanometers, is translucent to

1 transparent as suggested by Knowlton and turbidity at or below 150 NTU as
2 suggested by Margosiak."

3 An inherency argument requires that the extrinsic evidence -- here the
4 Knowlton and Margosiak being relied upon by the examiner -- must make
5 clear that the missing descriptive matter is necessarily present in the theme
6 described in the reference, and that it would be so recognized by those
7 persons of ordinary skill.

8 This is from In re Robertson, 49 USPQ2d at 1950, 1951.

9 However, Knowlton merely teaches that the missing subject matter is
10 a possibility and not a certainty. There's not a -- there's not a definite
11 correlation the way the examiner wishes to make it to be. Knowlton states
12 that, "It is foolish to generalize on the correlation of emulsion appearance
13 with the size of the dispersed phase particles."

14 Therefore, Knowlton cannot support a rejection based on inherency
15 because Knowlton itself teaches that this is merely a possibility.

16 Now, the examiner argues that --

17 JUDGE ADAMS: Well, does Knowlton say it's merely a possibility
18 or does he provide you with a reasonable expectation based on this idea that
19 different sized globules will reflect light differently, so as you reduce the
20 size of the oil globule, you're going to become more transparent in this
21 emulsion?

22 MS. HERZFELD: Well, it plainly teaches that the two main factors
23 influencing the appearance of emulsion are the particle size and the
24 refractive index differences between the two phases in the system. There are
25 two parts to this equation, and the examiner is trying to cut the second part
26 out and have it be a direct relationship.

1 JUDGE ADAMS: So it's your position that this globule size is not
2 related to the appearance of the emulsion.

3 MS. HERZFELD: No. I'm not saying that there is no relationship.
4 I'm saying it doesn't have the direct relationship. The 100 percent positive
5 all the time relationship that the examiner is making it out to be.

6 The examiner extrapolates it essentially with Margosiak and tries to
7 argue, as I previously quoted, that any nanoemulsion having an oil globule
8 size of less than 150 nanometers would have a transparent appearance and a
9 turbidity of less than 105 NTU.

10 JUDGE ADAMS: Well, I think the examiner -- I would agree that the
11 examiner may have overstepped to say that 150 nanometer oil globule size
12 will give you a translucent or transparent emulsion. I think that the K
13 reference would suggest that's a blue-gray emulsion. Is that right?

14 MS. HERZFELD: That -- yeah, that's what it would suggest, but it's
15 also that the examiner is trying to make a number per number direct
16 correlation that you simply cannot make. It's also been demonstrated with
17 our example in our specification that --

18 JUDGE ADAMS: Well, before you jump to the example, on page 1
19 of your spec, don't you make a correlation between the size of the particle
20 and the emulsion in its appearance?

21 (Pause in the proceedings.)

22 JUDGE ADAMS: Spec page 1, line 20.

23 MS. HERZFELD: I'm looking at the published version.

24 JUDGE ADAMS: Well, I would imagine it's still on the first page.

25 MS. HERZFELD: Right, right. So this --

26 JUDGE GRIMES: It's in the fourth paragraph.

1 MS. HERZFELD: Thank you.

2 Are you referring to the sentence where it says --

3 JUDGE ADAMS: It says, "The transparency of these emulsions" --

4 MS. HERZFELD: "Derives from the small size of the oil globules."

5 JUDGE ADAMS: Right.

6 MS. HERZFELD: So --

7 JUDGE ADAMS: Doesn't that sort of --

8 MS. HERZFELD: -- I'm not disputing that.

9 JUDGE ADAMS: Doesn't that sort of dovetail with the K reference --
10 in what the K reference teaches?

11 MS. HERZFELD: Well, it's the -- it has to do with the -- appellants
12 are not trying to say that there is no relationship. What appellants are saying
13 is that the legal standard of inherency requires that the cor -- you know, the
14 correlation that the examiner is asserting has to be necessarily present and as
15 it's being taught --

16 JUDGE GREEN: But your solution does have turbidity and that is an
17 inherent property of these solutions. They all have turbidity. I mean, the
18 Robertson case dealt with a diaper, whether or not it had a third fastening or
19 not.

20 I think from us to say from there that the examiner has to be 100
21 percent sure that this has your turbidity when we have no way of measuring
22 that, I mean, I think that's putting a lot and then it's kind have taken the
23 Robertson case a little far.

24 JUDGE ADAMS: Your turbidity range ranges from 60 to 600. That's
25 a pretty -- pretty broad turbidity range, yes?

26 MS. HERZFELD: Mm-hmm.

1 JUDGE ADAMS: Is there any evidence on this record to suggest that
2 the combination of R, the Restle and Ziegler references wouldn't produce an
3 emulsion that has a turbidity that's 150 -- or excuse me -- within that range
4 of 60 to 600 NTU?

5 MS. HERZFELD: I don't think either of them spoke about the
6 turbidity or the clarity of their emulsions -- of their solutions at all and --

7 JUDGE ADAMS: Right, but we have two new references before us --

8 MS. HERZFELD: Right.

9 JUDGE ADAMS: -- that talk about what one would reasonably
10 expect.

11 MS. HERZFELD: Well, first of all, the Board held that that
12 combination didn't lead to one of ordinary skill in the art --

13 JUDGE ADAMS: That's not the same prior art rejection before us.
14 We have a different prior art rejection before us that has two additional
15 references.

16 MS. HERZFELD: Right, but I mean, you just asked if the
17 combination of Restle and Ziegler would show this turbidity.

18 JUDGE ADAMS: Well, is there any evidence they wouldn't have that
19 turbidity?

20 MS. HERZFELD: Off the top of my head, no, but that wasn't -- that's
21 not the standard.

22 JUDGE ADAMS: But you're leaning on to your example in your
23 specification, and your example has one of its components as, I believe,
24 propylene glycol; is that right?

25 MS. HERZFELD: In phase B.

26

1 JUDGE ADAMS: Right, but do not all these phases get homogenized
2 together?

3 MS. HERZFELD: Mm-hmm.

4 JUDGE ADAMS: So that emulsion would contain propylene glycol,
5 right?

6 MS. HERZFELD: Mm-hmm.

7 JUDGE ADAMS: Can you tell me what Restle talks about as far as
8 transparency improving additives that he contemplates adding to his
9 emulsion?

10 (Pause in the proceedings.)

11 JUDGE ADAMS: To help you out, that would be approximately page
12 17 of the translation of Restle near the bottom of the page.

13 MS. HERZFELD: Did you want me to read it into the record or --

14 JUDGE ADAMS: Well, I just -- I wanted to direct your attention to
15 that. Restle says that you can improve the transparency of a formulation by
16 adding, among other things, propylene glycol.

17 MS. HERZFELD: Mm-hmm. But the crux of our invention is, going
18 back to the summary of our background which I never went into because we
19 jumped ahead, but the invention was directed at this -- the fact that having a
20 polymer with a hydrophilic and hydrophobic block improved the stability
21 and turbidity of the emulsion and --

22 JUDGE ADAMS: Well, I think your claim doesn't exclude the
23 addition of propylene glycol -- is that right -- as Restle would suggest as a
24 transparency improving agent? In fact, your example that you directed us to
25 includes it.

26 MS. HERZFELD: Right. Includes the propylene glycol.

1 JUDGE ADAMS: Right.

2 MS. HERZFELD: I mean, it's a common solvent. But what -- what
3 you're approaching here, which was not at all in the briefs, but is that -- well,
4 all these ingredients are out there. They're used in various cosmetic
5 compositions. You know, let's throw them together.

6 JUDGE ADAMS: No. Not at all. Restle and Ziegler, we've already
7 found, teaches this composition, right? Maybe not perhaps the exact
8 turbidity range that you're claiming -- claiming now, but in that composition
9 Restle specifically says you can add propylene glycol to it for the expected
10 advantage of improving transparency.

11 So it's not just a helter-skelter mixture of -- of various reagents that
12 are in the prior art as you're suggesting. There's direction specifically and
13 the reference has relied upon.

14 MS. HERZFELD: So I guess am I to understand that you're ignoring
15 the turbidity limitation.

16 JUDGE ADAMS: Absolutely not. I think that the two additional
17 references make up for that -- for that range. They provide a reasonable
18 suggestion to a person of ordinary skill in the art that this bluish-gray
19 emulsion taught by the combination of Restle and Ziegler would have a
20 turbidity that falls somewhere within that range. That's a huge range.

21 Unless, of course, you can provide a persuasive argument to suggest
22 otherwise.

23 MS. HERZFELD: Well, as I stated before, Knowlton and Margosiak
24 in combination don't teach that it's -- that has this positive correlation that
25 the examiner has been arguing. So it sounds like your --

1 JUDGE ADAMS: I mean, tell me why there wouldn't be a reasonable
2 expectation of success in observing a turbidity between 60 and 600 in an
3 emulsion taught by the combination of Ziegler and Restle.

4 MS. HERZFELD: Well, our example show that we have a cationic
5 polymer that has a hydrophilic block and a hydrophobic block that gets you
6 the turbidity in our range, and then when you replace it with a different
7 polymer, you're outside of the range. There are other factors involved.

8 JUDGE ADAMS: But Ziegler and Restle teach your polymers.

9 MS. HERZFELD: Ziegler talks about the polymer surviving three
10 soft cycles and not in terms of emulsion stability and clarity so --

11 JUDGE ADAMS: So because the reference doesn't talk about what
12 may be an inherent property -- or a reference doesn't talk about what may be
13 an inherent property of the composition, it therefore becomes superfluous.

14 MS. HERZFELD: Well, it doesn't mean that there's a reasonable
15 expectation of success that adding these things together are going to give
16 you the composition with our turbidity.

17 JUDGE ADAMS: Well, you say your composition has a blue-gray
18 appearance, right? And Knowlton says that compositions that have this
19 particular particle size will have a blue-gray appearance.

20 MS. HERZFELD: In a general manner, but it also says there are other
21 factors that work, one of them being the refractive index and that's affected
22 by the different polymers that are put together and how they mesh into an
23 emulsion.

24 JUDGE ADAMS: And then both your example and Restle talk about
25 using a -- or Restle talks about using a transparency improving additive,
26 which happens to be propylene glycol, which you use in your example.

1 MS. HERZFELD: Yes, but that's 1 ingredient out of 25. I mean, if
2 there were 4 ingredients, then maybe you would have an expectation that
3 could this transparency improve or end.

4 JUDGE ADAMS: Is there only four ingredients in Restle's emulsion?

5 MS. HERZFELD: No, but --

6 JUDGE ADAMS: So therefore, his teaching that the addition of a
7 propylene glycol to his emulsion is superfluous.

8 MS. HERZFELD: This is -- what I would -- actually, the examples in
9 Restle have very few ingredients compared to the emulsions taught in -- of
10 the present specification.

11 Second, the -- what I'm hearing from you is the standard is now that
12 there's -- there's just a reasonable expectation that this element is taught by
13 the references --

14 JUDGE ADAMS: I'm just asking you questions. We haven't made
15 any conclusions on the record yet.

16 MS. HERZFELD: Okay. Because, you know, the case was argued
17 throughout its prosecution based on the premise of all elements needing to
18 be taught, and what I hear you saying is that, well, there's a reasonable
19 expectation that, you know, it's close enough. That it's there.

20 And not that it's actually being taught because what we're saying is
21 that Knowlton, having its -- its disclaimer, its truthful statement that you
22 can't always guarantee that the size is going to relate to the turbidity means
23 that something is not necessarily present and it hasn't been taught and the
24 examiner can't rely on it being taught, and especially can't rely on this made
25 up proportion of 150 nanometers having 105 NTU.

1 So it sounds as though the standard is being moved away from there,
2 and -- I mean, appellants still contend that this case is not obvious under the
3 art, and that the references that the examiner has cited don't overcome the
4 fact that the primary references don't teach the claim limitations.

5 But if that were the standard that you were going to apply, then
6 appellant would rather have -- rather that you agree with the prosecution and
7 let them go back and argue with the examiner under this different standard.

8 JUDGE ADAMS: We're running a little short on time. Did you want
9 to address the other dependant claim, claim 64, I believe it was, or 63?

10 MS. HERZFELD: Yeah. Yeah, really quickly, if I could, please.

11 JUDGE ADAMS: And that one doesn't have this turbidity range; is
12 that --

13 MS. HERZFELD: Correct. It does not have the turbidity range.

14 JUDGE ADAMS: But it requires this aminosilicate; is that right?

15 MS. HERZFELD: It has aminosilicone.

16 JUDGE ADAMS: So the M and K references don't really play a part
17 in this part of the examiner's rejection; is that right?

18 MS. HERZFELD: Correct.

19 JUDGE ADAMS: And going back in 2004 we already reversed that
20 combination but for the M and K references over this claim, right?

21 MS. HERZFELD: What you said was that the examiner has not
22 provided sufficient evidence or sound scientific reasoning to show that those
23 skilled in the art would have been motivated to select the aminosilicone
24 disclosed by Decoster as useful in a cosmetic determined detergent
25 composition and to add that aminosilicone to the oil and water nanoemulsion
26 suggested by Restle and Ziegler.

1 JUDGE ADAMS: Is there anything new to the examiner's argument
2 that wasn't presented in 2004 that would -- that would suggest that he made
3 up for those deficiencies?

4 MS. HERZFELD: No.

5 JUDGE ADAMS: Anything else you wanted to add about that claim?

6 MS. HERZFELD: About --

7 JUDGE ADAMS: That --

8 MS. HERZFELD: -- claim 64 through 67? No. Just, you know, the
9 examiner, I think, ignores the decision of the Board and essentially makes
10 the same argument again. You know, applicants -- or appellants previously
11 argued with the examiner that the aminosilicone is taught in combination in
12 Decoster.

13 There's no motivation to pull it out of this combination, and the
14 examiner argues that well, you have an open claim, and you don't say you
15 can't, so I can, and I think that sort of turns the standard of obviousness on
16 its head.

17 There should be a motivation. It shouldn't just be, well, there's no
18 prohibition on making this combination. There needs to be something in the
19 art directing you --

20 JUDGE ADAMS: Well, I think your appellate brief explains that this
21 particular reference the examiner's relying upon to reach this aminosilicone
22 limitation requires a very particular set of ingredients, so therefore, as I
23 understand your brief, why would one necessarily pull the aminosilicate out
24 of that and add it into the other combination?

25 MS. HERZFELD: Right.

1 JUDGE ADAMS: Or alternatively, take that whole set of ingredients
2 and put it in --

3 MS. HERZFELD: Right. And the examiner is saying, Well, you
4 don't say you can't, and we would say that just because we don't say you
5 can't, doesn't mean there's motivation.

6 JUDGE ADAMS: Anything else?

7 MS. HERZFELD: The appellants would just reiterate that I mean, the
8 examiner has said that the claimed invention is closely identical to what he
9 views what her extrapolated conclusions are from the art, and we don't think
10 that closely identical is the standard.

11 It wasn't the standard then and we don't think it's the standard now
12 under KSR. There still has to be some reasoning, some non-hindsight-based
13 reasoning for making these combinations.

14 And we would also point out that KSR, like the other big Supreme
15 Court 103 cases -- Hotchkiss, Graham, Calmar -- were all mechanical cases,
16 and that rationale involved with mechanical cases, I think, do not translate as
17 well into chemical cases where there is a lot more uncertainty in the end
18 behavior of -- are rizzled (phonetic) in composition when you combine
19 elements.

20 So we would, of course, first admit that not all the elements are
21 taught, but if you were to find that they were all there --

22 JUDGE ADAMS: Okay. We're about six minutes over if you want to
23 start wrapping it up.

24 MS. HERZFELD: That would be our --

25 JUDGE ADAMS: Okay. Well, thank you for your time.

1 MS. HERZFELD: Thank you.
2 (Whereupon, the proceedings at 1:26 p.m. were concluded.)
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